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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/341,921

Applicant(s)

BERND BESSLING et al

Examiner

VIRGINIA MANOHARAN

Group Art Unit

1764



☒ Responsive to communication(s) filed on Oct 28, 1999

☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The abstract of the disclosure is objected to because of the inclusion of legal phraseology often used in patent claims. For example "comprising" recited in lines 2 and 3 of the abstract. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: the heading "Brief Description of the Drawing" is suggested to be incorporated into the specification.

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The "100 m2/m3" recited in claim 4 is not positively recited in the specification.

The specification has not been checked to the extent necessary to determine the presence of all possible mirror errors e.g., typographical, grammar, idiomatic, syntax and etc. Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The "Xmin" recited e.g., in claims 2-3 is not specified in the claims.

B. It is unclear from claim 1, as recited, how a mixture containing less than 5% by weight of ethylene oxide is obtained from the bottom phase by the mere distillation step. No regulation nor process step is recited to obtain and control said amount to "less than 5% by weight of ethylene oxide".

C. The claimed "the bottom phase" recited in claim 1, line 8, lacks antecedent support in the claims.

D. The use of a parenthetical statement in a claim is improper as every feature recited in a claim becomes a part of the overall subject matter. By placing terms in parenthesis renders the claims ambiguous as to whether or not the phrases should be disregarded. See claim 2 recitation of "(in m)" and "(in M2/m3)". Also, the "m" is not specified in the claims.

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F. The following claimed languages such as: "principally" recited in claim 6; and "In comparison" recited in claim 8, both fail to ascertain the claimed invention with precision.

E. It is unclear whether "a distillation apparatus" recited in claim 8 is different or the same as the "a distillation apparatus" initially recited in claim 1. See also claim 9. Replacing the article "a" in claims 8 and 9 to - the - obviates this rejection.

G. Some of the structural elements of the distillation apparatus recited in claim 10 are already redundantly recited in the claims from which it depends i.e., claim 7 and ultimately claim 1, claimed twice?

Reciting claim 10 in independent form obviates this rejection.

H. The claims are indefinite because they fail to set forth the active, actual physical process steps i.e., the used of past tense and passive voice make for confusion and ambiguity.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leis et al or Worrell.

Leis et al or Worrell is deemed to anticipate or renders obvious the claimed apparatus as claimed in claim 10. See e.g., the abstract of Worrell and at col. 2, lines 59-6 of the Leis et al reference.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '323 in view of Coffey or Gilman et al.

EP '323 discloses substantially the process as claimed. The process of EP '323 differs from the claimed invention in that claim 1 for example, recites that "in the bottom phase, a mixture is obtained which contains less than 5% by weight of ethylene oxide".

However, said difference is deemed not to constitute a patentable distinction inasmuch as the percentage by weight of the ethylene oxide is deemed to be a result-effective variable which ordinarily is within the skilled o the art.

[The same holds time for the claimed height in claim 3 and the specific mass transfer area claimed in claim 4]

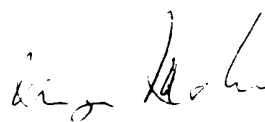
As evidence, see e.g., col. 4, lines 9-12 of the Coffey's reference; and at col. 5, lines 45-61, of the Gilman et al reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Manoharan whose telephone number is (703) 308-3844. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms Marian Knode, can be reached on (703) 308-4311. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) **308-0651**.

V. Manoharan/om
October 17, 2000



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10/19/00